

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/675,969 Confirmation No. 6294
Applicant : Hong-Ki KIM et al.
Filed : October 2, 2003
Tech Cntr/AU : 2178
Examiner : Samir Termanini
Entitled : METHOD, DISPLAY SYSTEM AND COMPUTER SOFTWARE
FOR CONTROLLING ICON APPEARANCE
Attorney Reference : 123016-05004702
Customer Number : 22429

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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COMMISSIONER FOR PATENTS

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Sir:

This paper is submitted in reply to the Final Office Action mailed January 8, 2008.

Applicants respectfully request review of the final rejections of all claims as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

REASONS

The following clear errors are found in the Examiner's rejections.

1. With respect to independent **claim 1**, the applied references, especially *Bogdan*, fail to teach or suggest the last paragraph of independent claim 1, i.e., "backing up the display properties occurs automatically in response to the inputs for a new icon appearance being received from the user through the icon control window and is performed immediately prior to changing the at least one sample icon's appearance." Extensive traversing arguments have been provided in the October 25, 2007 Amendment, at page 12 line 1 through page 14 line 7 from bottom. The previous arguments are incorporated by reference herein for the panel's review.

The Examiner's additional reliance on *Rive* for the above claim limitation is noted. Applicants respectfully disagree with the Examiner's obviousness rationale for at least the following reasons.

1.1. First, *Rive* is non-analogous art.¹ A person of ordinary skill in the art would at once recognize that *Rive* relates to method and apparatus for remotely enabling a preinstalled and previously disabled application on a computer system.² The reference, therefore, does not at all belong to the field of the invention, i.e., icon appearance customization.³

The question to be asked now is whether *Rive*, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole. The answer is No, because the matter with which *Rive* deals, i.e., remote application

¹ "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole. *MPEP*, section 2141.01(a).l. (emphasis added).

² See, *Rive* at Title and Abstract.

³ See, for example, Title and Abstract of the instant application.

enabling, is absolutely unrelated to the problem of the present invention, i.e., icon appearance control. In fact, no teaching in *Rive* logically would have commended itself to an inventor's attention in considering his or her invention related to icon appearance control. Thus, *Rive* is not reasonably pertinent to the present invention.

Since *Rive* is neither in the field of endeavor of the invention nor reasonably pertinent to the invention, it is non-analogous art that cannot be applied in a 35 U.S.C. 103(a) rejection.

1.2. Second, even if *Bogdan* was properly combinable with *Rive*, which Applicants contend to the contrary for the reason detailed immediately above, the combination would still fail to teach or suggest the last paragraph of independent claim 1. The Examiner's analysis⁴ has failed to properly identify how *Bogdan* in view of *Rive* would teach or disclose the claim limitation at issue.

Specifically, the Examiner essentially argued that it would have been obvious to use the registry for storing back-up information. The Examiner's argument is thus addressing where the prior art teaches or suggests to store backed-up information. The claim limitation, however, specifies when the backing-up operation occurs, i.e., "in response to the inputs" and "immediately prior to changing the at least one sample icon's appearance." Therefore, the references as applied/combined by the Examiner would still fail to teach or suggest the claim limitation at issue.

1.3. It should be noted that none of the applied references fairly teach or suggest the following sequence⁵ of the claimed steps:

user input → backing-up of display properties → changing of sample icon's appearance

⁴ See Final Office Action mailed January 8, 2008 at page 6, line 10 from bottom through page 7 line 12.

⁵ See claim 1, at the last paragraph.

In FIG. 4 of *Bogdan*, the Examiner considers step 56 as “backing-up of display properties.”⁶ Step 58 should be then considered as “user input” and the reference’s sequences

backing-up of display properties (56, FIG. 4) → user input (58, FIG. 4)

is in the reversed order compared to the claimed one.

Rive as applied by the Examiner ⁷ *appears* to require backing up data/application before changes are made to the data/application. Thus, even if the Examiner is correct that data/application of *Rive* is readable on the claimed “display properties,” the reference as applied by the Examiner only teaches

backing-up of display properties → changing of display properties

In other words, in *Rive* as applied by the Examiner, the information being backed-up and the information to be changed are one and the same. In contrast, the claimed invention requires that the information being backed-up (i.e., display properties) and the information to be changed (sample icon’s appearance) are different.

The rejection of claim 1 as formulated by the Examiner is therefore improper and should be withdrawn.

2. Still with respect to independent claim 1, the applied references, especially *Bogdan*, fail to teach or suggest the claim feature “by generating a first registry subkey in a memory of the display system if the display properties are determined to be valid.” Traversing arguments have been provided in the October 25, 2007 Amendment, at page 15 lines 3-13. The previous arguments are incorporated by reference herein for the panel’s review.

⁶ See Final Office Action mailed January 8, 2008 at page 5, last senten.

⁷ See Final Office Action mailed January 8, 2008 at page 6, lines 4-5 from bottom.

The Examiner has failed to responded to Applicants' traversing arguments. Specifically, the final rejection of claim 1 ⁸ is a word-by-word copy of the previous rejection,⁹ and still includes the Examiner's argument that *Bogdan* teaches/suggests the above-highlighted claim feature. Applicants respectfully disagree, because, as already discussed in the October 25, 2007 Amendment, the reference's software compatibility is not readable on the claimed display properties.

3. With respect to claims 2-13 and 37-38, the claims are considered patentable at least for the reasons advanced with respect to the independent claim 1.

As to **claims 10, 11 and 13**, note the discussion *supra* in section 3 with respect to a similar limitation of claim 1, i.e., the reference's software compatibility is not readable on the claimed display properties.

As to **claim 38**, the cited portion of *Bogdan* ¹⁰ does not teach or suggest the claim feature that "the change in the sample icon's appearance is performed with respect to the backed-up display properties." The cited portion of *Bogdan* discloses at best a change in the icon's appearance in accordance with user input, rather than any back-up information. It should be noted that claim 38 is directed to the inventive feature that restores the display properties to the backed-up values. *Bogdan* as applied by the Examiner fails to teach or suggest any such restoration.

4. With respect to claims 14-22, note the discussions *supra* with respect to claims 1-9, respectively.

5. With respect to claims 23-35, note the discussions *supra* with respect to claims 1-13, respectively.

⁸ See Final Office Action mailed January 8, 2008 at page 3, line 8 from bottom through page 5 last line.

⁹ See Office Action mailed June 29, 2007 at page 3, line 6 through page 5, line 4 from bottom.

¹⁰ *Bogdan* at column 4 lines 50-60 per Final Office Action at page 14, line 3.

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Withdrawal of the final rejections in view of the above is believed appropriate and therefore respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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